Attorney Docket No.: 205733US0

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: :

Kenichi UEYAMA, et al. : EXAMINER: GOLLAMUDI, Sharmila S.

SERIAL NO. : 09/832,897 : GROUP ART UNIT: 1616

FILED: APRIL 12, 2001 :

FOR: METHOD OF TREATING HAIR :

RESPONSE AND REQUEST FOR RECONSIDERATION

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

In response to the outstanding Official Action of December 26, 2002 reconsideration of the above-identified application is respectfully requested in light of the following remarks.

REQUEST FOR RECONSIDERATION

Claims 1-5 and 7 remain active in this application.

The present invention is directed to a method of treating hair and a pre-shampoo treatment.

Methods for treating hair which result in improved feel, stylability and manageability have typically been treatment of shampooed wet hair. Unfortunately, such conventional hair treatment methods leave room for improved performance in terms of feel and stability.

The present invention addresses this problem by providing a method for treating hair comprising applying to **dry** hair a composition comprising an oil agent and a solvent wherein

the water content of the **composition** is 20 wt% or lower. The present invention is also provided for by a preshampooed treatment composition comprising 0.5-50% by weight of an oil agent, a solvent selected from the group consisting of C_{1-6} alcohol, an aromatic alcohol and a mixture thereof, and a water content of from 0-20 wt%. Applicants have discovered that such a method and composition provides for hair treatment of improved feel and stability and manageability. Such a method and composition are nowhere disclosed or suggested in the cited prior art of record.

Claims 1-5:

This embodiment of the present invention is directed to methods of treating hair comprising applying a hair treatment composition to **dry** hair.

The rejection of Claims 1-5 under 35 U.S.C. § 102(b) over Altobelli et al U.S. 5,110,318 is respectfully traversed.

Altobelli et al fail to disclose or suggest a method in which a hair treatment composition is applied to **dry** hair and washed away.

Altobelli et al describes a method in which the hair coloring composition is applied in a one-step coloring and conditioning process in which prior to application of the composition to the hair, the hair is shampooed and **excess water** is squeezed out (col. 6, lines 10-18). During the shampooing process, water in introduced onto the hair and the excess water is squeezed out. The reference teaches to apply the composition to **wet** hair. While it is asserted in the outstanding Official Action that such a process produces "sufficiently dry hair", such a process does not describe a method in which a hair treatment composition is applied to **dry hair** as the term must be understood by the specification.

Applicants respectfully submit that a process of shampooing hair followed by squeezing out the excess water does not produce dry hair and accordingly, does not anticipate or suggest the claimed method.

In order to quantify the amount of water which would remain in the hair after shampooing then squeezing the excess water out, Applicants have conducted tests which measured the amount of water remaining in hair after shampooing then 1) squeezing out the excess water and 2) towel drying. The tests were performed by shampooing hair, then either squeezing out the excess water or towel drying, then comparing the weight of the hair against the weight of dry hair. The data is summarized below:

Moisture content after squeezing out excess water	Moisture content after towel drying
94%	57.6%

In the cases of squeezing out the excess water and towel drying, the remaining amount of water was far in excess of 30 wt.% of water.

In contrast, the present invention is directed to a method of treating hair in which a hair treatment composition is applied to **dry** hair then **washed** away. Applicants note that the claims specifically recite that the composition is applied to dry hair and washed away, process steps which are not found in the reference cited. Applicants further note, that the specification describes "dry hair" on page 4, lines 14-17 as excluding wet hair, and may be quantitatively be represented by a water content of **not more than 30% by weight,** preferably 20% by weight or less. As such, Applicants' claim limitation of "dry hair" clearly is not suggested by the reference of Altobelli et al which describes the application of a hair

composition to wet hair, in which the amount of water is suggested to be in the range of 57 to 94%. The cited reference fails to teach the claim limitation of applying the composition to "dry hair" and as such the claimed invention is neither anticipated nor made obvious from this reference.

> To establish a *prima facie* case of obviousness, three **basic** criteria must be met. First there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one or ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must **be a reasonable expectation of success**. Finally, the prior art reference (or references when combined) must teach or suggest **all the claim limitations**. (M.P.E.P. 2143) (emphasis added)

Accordingly, the Examiner must 1) find prior art references which teach or suggest all the claim limitations; 2) provide motivation to combine or modify the prior art teachings, found in the references or from knowledge generally available to those of ordinary skill in the art; and 3) show how the prior art provides for a reasonable expectation of success.

Since the cited prior art of record fails to disclose or suggest the claim limitation of "dry hair" the present invention is clearly not anticipated nor obvious from the cited reference and accordingly, withdrawal of the rejection under 35 U.S.C. § 102(b) is respectfully requested.

Claim 7:

This embodiment of the present invention is directed to a **pre**-shampoo treatment.

A **pre**-shampoo treatment comprising 0.5-50% by weight of an oil treatment, a solvent selected from the group consisting of **C_{1-6} alcohol and aromatic alcohol** and a mixture thereof and from 0-20% by weight by water is nowhere disclosed or suggested in the cited prior art of record.

Altobelli fails to describe a hair treatment composition comprising 0.5 to 50 wt.% of an oil agent and a **solvent** selected from the group consisting of a C_{1-6} alcohol and aromatic alcohol and a mixture thereof and from 0-20% by weight by water. The reference fails to describe any solvent for the oil agent, and quite to the contrary the reference suggest that the oil agent exist as a separate phase from the aqueous phase. As such there is no suggestion of the presence of a solvent for the oil agent.

Moreover, there is no suggestion of the solvent for the oil agent being a C_{1-6} or aromatic alcohol in an amount of water of 0 to 20 wt.%. While the examiner has previously cited to the examples of the reference for a composition containing a oil agent, glycerine as a solvent and water, in all of the examples, the amount of water is **in excess** of 20 wt.% (example 1: 22.75 wt.%, example 2: 50.53 wt. % and example 23: 57.1 wt.%). As such, in each example for which the examiner cites to the presence of a solvent for the oil agent (e.g. glycerin), the amount of water is in excess of the **claim limitation** of 0 to 20 wt.% water. Clearly none of the examples of the reference anticipate the claimed invention as each of the examples contain an amount of water in excess of the claimed range of from 0 to 20 wt.%.

Since the reference does not suggest a composition which contains a solvent for the oil component, and the examples which contain a C_{1-6} alcohol (glycerin) contain an amount of water in excess of the claimed range of 0 to 20 wt. %, the claimed invention is clearly neither anticipated nor obvious from the cited reference.

Accordingly, this reference can neither anticipate nor render obvious the claimed pre-shampoo treatment. Since the cited references fail to disclose or suggest the pre-shampooed treatment composition as claimed, the claimed invention is neither anticipated nor obvious

from the cited reference and accordingly withdrawal of the rejection under 35 U.S.C. § 102(b) is respectfully requested.

Applicants submit this application is now in condition for allowance and early notification of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Norman F. Oblon
Attorney of Record
Registration No. 24,618

Richard L. Chinn, Ph.D.
Registration No. 34,305

22850

Telephone: (703) 413-2220
Facsimile: (703) 413-2220
RLC:dbl